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10/800,095

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Fay Chong JR.

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MARTINE PENILLA & GENCARELLA, LLP  
710 LAKEWAY DRIVE  
SUITE 200  
SUNNYVALE, CA 94085

EXAMINER

PAPE, ZACHARY

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UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE BOARD OF PATENT APPEALS  
AND INTERFERENCES

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*Ex parte* FAY CHONG JR.

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Appeal 2009-002542  
Application 10/800,095  
Technology Center 2800

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Decided: September 04, 2009

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Before CATHERINE Q. TIMM, KAREN M. HASTINGS, and  
JEFFREY B. ROBERTSON, *Administrative Patent Judges*.

ROBERTSON, *Administrative Patent Judge*.

DECISION ON APPEAL

STATEMENT OF THE CASE

Appellant appeals under 35 U.S.C. § 134(a) from the Examiner's final rejection of claims 1-16, which are all of the currently pending claims. (Appeal Brief filed February 1, 2007, hereinafter "App. Br.," 3). We have jurisdiction pursuant to 35 U.S.C. § 6(b).

We REVERSE.

Appellant describes a component positioning and securing bracket assembly. Claims 1 and 10, the only independent claims on appeal, are illustrative and recite:

1. A component positioning and securing bracket assembly, comprising:

a front rail, a rear rail, and a bottom rail to define a front, a rear, and a bottom boundary of the component positioning and securing bracket assembly, the front rail, the rear rail, and the bottom rail defining a structure into which is received the component;

a top plate for attaching to the component, the top plate including a keyed tail portion;

a tail receptacle for receiving the keyed tail portion, the tail receptacle configured to the rear rail;

a nose receptacle portion of the front rail for receiving a nose portion of the top plate;

a component connector to connect to a port of the component; and

a lever to provide leveraged motion, the leveraged motion causing the keyed tail portion to be received into the tail receptacle to positively hold and rigidly support the component in place and effecting a connection of the port of the component and the component connector and securing the component in the component positioning and securing bracket,

wherein the component positioning and securing bracket assembly is in an array of a plurality of components.

10. In an array of a plurality of disk drive components, a disk drive positioning and securing bracket assembly, comprising:

a device surrounding component for holding a disk drive;

a forward mounting post attached to an array chassis;

a rear mounting post attached to the array chassis; and

a lever to provide leveraged movement to the disk drive, the lever positioned on a side surface of the disk drive to be located within the array of the plurality of disk drive components,

wherein the device surrounding component includes a device positioning key and forward tabs, the device positioning key and forward tabs configured to be received in the rear mounting post and in the forward mounting post such that the device surrounding component having the disk drive therein is received in the rear mounting post and in the forward mounting post in a first direction of motion, and the lever provides leveraged movement in a second direction of motion positioning the device positioning key into the forward tabs to secure the disk drive.

The prior art relied upon by the Examiner in rejecting the claims on appeal is:

Aoki	US 6,288,911 B1	Sep. 11, 2001
Roesner	US 2005/0047075 A1	Mar. 3, 2005
		(filed Aug. 26, 2003)

The Examiner rejected claim 10 under 35 U.S.C. § 112, first paragraph, as failing to comply with the written description requirement. The Examiner rejected claims 1-10, 12, 13, 15, and 16 under 35 U.S.C. § 102(e) as being anticipated by Roesner. The Examiner rejected claims 11 and 14 under 35 U.S.C. § 103 (a) as being unpatentable over Roesner in view of Aoki.

The Examiner found that claim 10 fails to comply with the written description requirement because “[t]here is no support anywhere in the original disclosure for a device having both a device surrounding component and a lever positioned on a side surface of a disk drive.” (Examiner’s Answer entered June 4, 2007, hereinafter “Ans.,” 4).

The Examiner found that Roesner discloses a component positioning and securing bracket assembly including a top plate (42) having a keyed tail portion (70) and a tail receptacle (94) for receiving the keyed tail portion as recited in claim 1. (Ans. 4). The Examiner also found that the “elements 40, 42, and 44 are taught by Roesner as being an integral structure (see [0015] 9-10) and therefore the keyed tail portion (70) is included in the top plate (42).” (Ans. 10). The Examiner additionally found that Roesner discloses a disk drive positioning and securing bracket assembly (16) including a lever positioned on a side surface of the disk drive as recited in claim 10. (Ans. 6). The Examiner found that “the lever (24) is positioned on a side surface of the disk drive (Via the device surrounding component).” (Ans. 11).

Appellant contends that the Examiner has interpreted “device surrounding component” recited in claim 10 as enclosing the disk drive on all sides, which is not consistent with the Specification. (App. Br. 6-9). Appellant argues that there is clear support in the Specification for positioning the lever on a side surface of the disk drive, and that the device surrounding component does not preclude positioning the lever on the side surface of the disk drive. (App. Br. 9).

Appellant also contends that Roesner does not teach a top plate including a keyed tail portion as recited in claim 1. (App. Br. 11). Appellant argues that the guide 70, relied on by the Examiner to teach the

keyed tail portion, is not part of the support member of Roesner relied upon by the Examiner to disclose the top plate. (App. Br. 11). Appellant argues that though Roesner discloses the different support members may form an integral structure, “Roesner does not blur the distinction between the support members 40, 42, and 44 as representing separate components having respective functional responsibilities.” (App. Br. 11-12). Regarding claim 10, Appellant contends that “Roesner does not teach the actuator 24 [lever] as being positioned on a side surface of the disk drive 14, as required by claim 10.” (App. Br. 13).

## ISSUES

The issues on appeal are:

Has Appellant shown reversible error in the Examiner’s finding that the Specification fails to provide adequate written description for a disk drive positioning and securing bracket assembly having “a device surrounding component for holding a disk drive” and a “lever positioned on a side surface of the disk drive” as recited in claim 10?

Has Appellant shown reversible error in the Examiner’s finding that Roesner describes a top plate including a keyed tail portion as recited in claim 1?

Has Appellant shown reversible error in the Examiner’s finding that Roesner describes a disk drive positioning and securing bracket assembly including lever positioned on a side surface of the disk drive as recited in claim 10?

### FINDINGS OF FACT

The record supports the following Findings of Fact (FF) by a preponderance of the evidence.

1. Appellant's Specification states: "[i]n one embodiment of the invention, lever 200 is attached to hard drive 130 at pivot pin 202. In other embodiments, pivot pin 202 is attached to device surrounding component 151 (see Figure 3A), or to top plate 121 (see Figure 2A)." (Spec. [0056]).
2. Appellant's Specification states: "[d]evice surrounding component 151 includes a top rail 151d, a rear rail 151a having a 'T-bar' device positioning key, a bottom rail 151e, and forward tabs 151f." (Spec. [0046]; Fig. 3A).
3. Appellant's Specification states: "[i]n another embodiment of the invention (not illustrated), a bracket includes a device-surrounding cage. Similar to the embodiment illustrated in Figures 3A-3D, the device-surrounding cage functions similar to the surrounding component 151 (see Figure 3A), but would encase all sides of the exemplary hard drive 130." (Spec. [0058]).
4. Roesner's Figure 2B is reproduced below:



Figure 2B depicts the bottom view of a drive carrier that includes actuator 24 (lever), drive carrier 12 including support members 40, 42, and 44, and guide 70. (Para. [0015], [0018]).

5. Roesner discloses that guide 70 is disposed along support member 44. (Para. [0018]).
6. According to the Examiner, support member 42 represents the top plate of the drive carrier. (*See* FF 3, Ans. 4).
7. Roesner discloses that actuator 24 is coupled to support member 42 or may be otherwise coupled to drive carrier 12. (Para. [0016]).

# PRINCIPLES OF LAW

35 U.S.C. § 112, first paragraph states that “[t]he specification shall contain a written description of the invention.”

In order to satisfy the written description requirement, the disclosure as originally filed does not have to provide *in haec verba* support for the claimed subject matter at issue. *See Fujikawa v. Wattanasin*, 93 F.3d 1559, 1570, 39 USPQ2d 1895, 1904 (Fed. Cir. 1996). Nonetheless, the disclosure must ... convey with reasonable clarity to those skilled in the art that ... [the inventor] was in possession of the invention. *Vas-Cath Inc. v. Mahurkar*, 935 F.2d 1555, 1563-64, 19 USPQ2d 1111, 1117 (Fed. Cir. 1991). Put another way, one skilled in the art,



reading the original disclosure, must immediately discern the limitation at issue in the claims. *Waldemar Link GmbH & Co. v. Osteonics Corp.*, 32 F.3d 556, 558, 31 USPQ2d 1855, 1857 (Fed. Cir. 1994). That inquiry is a factual one and must be assessed on a case-by-case basis. *See Vas-Cath*, 935 F.2d at 1561, 19 USPQ2d at 1116.

*Purdue Pharm. L.P. v. Faulding Inc.*, 230 F.3d 1320, 1323-24 (Fed. Cir. 2000).

“A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference.” *Verdegaal Bros., Inc. v. Union Oil Co. of Cal.*, 814 F.2d 628, 631-32 (Fed. Cir. 1987).

## ANALYSIS

### *Rejection under 35 U.S.C. § 112, 1<sup>st</sup> Paragraph*

We agree with Appellant, that when viewed in light of the Specification, one skilled in the art would have understood that the “device surrounding component” does not require that the sides of the disk drive are surrounded. In describing the “device surrounding component,” Appellant describes top, rear, bottom, and forward constituents, but does not refer to, much less require any side constituents. (FF 2). Moreover, Appellant distinguishes the term “device surrounding component” from “device surrounding cage,” which is described in the Specification as encasing all sides of the exemplary hard drive. (FF 3). Therefore, the device surrounding component does not require that the disk drive be surrounded on its sides.

In addition, Appellant's Specification discloses that the lever may be attached directly to the hard drive through a pivot pin. (FF 1). Therefore, one skilled in the art would have understood that Appellant was in possession of a disk drive positioning and securing bracket assembly including both a device surrounding component and a lever as recited in claim 10.

*Rejection under 35 U.S.C. § 102(e)*

*Claim 1*

Roesner discloses that the guide 70 is disposed along the lower portion of support member 44. (FF 5). Even though Roesner discloses that support members 40, 42, and 44 may be integral, support member 44 is different than support member 42, which the Examiner found to correspond to the top plate. Thus, we agree with Appellant that the Examiner erred in finding that guide 70 is disposed on support member 42.

Moreover, if support member 44 was interpreted to be the top plate containing guide 70, claim 1 would still not be anticipated by Roesner. For example, when viewing support member 44 as the top plate, the front and rear rails would either be 40 or 42, and would not possess a "tail receptacle configured to the rear rail" or "a nose receptacle portion of the front rail for receiving a nose portion of the top plate" as required by claim 1. (*See* FF 4).

*Claim 10*

Claim 10 recites that "the lever [is] positioned on a side surface of the disk drive." We agree with Appellant, that this language requires direct positioning of the lever on the surface of the disk drive, and not on some intervening material. Accordingly, since Roesner teaches that actuator 24 is

coupled to support member 42 or another portion of drive carrier 12, the Examiner erred in finding that Roesner anticipates claim 10.

Since we have found that the Examiner erred in finding that claim 10 was anticipated, we also reverse the rejection of claims 11 and 14 under 35 U.S.C. § 103(a), which depend from claim 10. The Examiner has offered no rationale as to how Aoki remedies the deficiencies of Roesner as discussed *supra*.

### CONCLUSION

Appellant has demonstrated that the Examiner reversibly erred in finding that the Specification fails to provide an adequate written description for a disk drive positioning and securing bracket assembly having “a device surrounding component for holding a disk drive” and a “lever positioned on a side surface of the disk drive” as recited in claim 10.

Appellant has demonstrated that the Examiner reversibly erred in finding that Roesner describes a top plate including a keyed tail portion as recited in claim 1.

Appellant has demonstrated that the Examiner reversibly erred in finding that Roesner describes a disk drive positioning and securing bracket assembly including lever positioned on a side surface of the disk drive as recited in claim 10.

### ORDER

We reverse the Examiner’s decision rejecting claim 10 under 35 U.S.C. § 112, first paragraph, as failing to comply with the written description requirement.

Appeal 2009-002542  
Application 10/800,095

We reverse the Examiner's decision rejecting claims 1-10, 12, 13, 15, and 16 under 35 U.S.C. § 102(e) as being anticipated by Roesner.

We reverse the Examiner's decision rejecting claims 11 and 14 under 35 U.S.C. § 103 (a) as being unpatentable over Roesner in view of Aoki.

REVERSED

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